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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Guenther et al.

Title: GAME BALL LACING

Appl. No.: 10/625,325

Filing Date: July 23, 2003

Examiner: Steven B. Wong

Art Unit: 3711

Mail Stop: APPEAL BRIEF - PATENTS
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ATTENTION: Board of Patent Appeals and Interferences

REPLY BRIEF UNDER 37 CFR 41.41

Dear Sir:

This Reply Brief is filed in accordance with 37 C.F.R. §41.41(a)(1). Appellants herewith file their Reply Brief in the above-identified case, in response to the Examiner's Answer mailed on April 30, 2009.

i. REAL PARTY IN INTEREST

Wilson Sporting Goods Co. is the real party of interest by virtue of an assignment of the above-referenced application from the inventors, Douglas G. Guenther, Kevin L. Krysiak and Kevin J. Murphy, to Wilson Sporting Goods Co. The Assignment was recorded in the U.S. Patent and Trademark Office at Reel 014328, Frame 0852. Wilson Sporting Goods Co. is a Delaware Corporation having a principal place of business at 8750 W. Bryn Mawr Avenue, Chicago, Illinois 60631.

ii. RELATED APPEALS AND INTERFERENCES

Appellants filed an Appeal under 37 C.F.R. § 41.31 with respect to U.S. Patent Application Serial No. 11/018,628, which is a division of the present Application. No decision has been rendered by the Board regarding this Appeal to date.

iii. STATUS OF CLAIMS

a. STATUS OF ALL CLAIMS

Claims 1-14 and 51-64 are pending in the present Application. Claims 15-50 have been canceled. The present Appeal is directed to claims 1-12, 14 and 51-64, which were finally rejected in an Office Action mailed June 12, 2007. Claims 1-14 and 51-64 were provisionally rejected on the ground of nonstatutory obviousness-type

double patenting. Appellants do not object to this rejection and are prepared to submit a terminal disclaimer to obviate the double patenting rejection.

b. CLAIMS ON APPEAL

Claims 1-12, 14 and 51-64 are on appeal.

iv. STATUS OF AMENDMENT

No amendment has been filed subsequent to the final rejection of the single claim.

v. SUMMARY OF CLAIMED SUBJECT MATTER

The present application is directed to a football including a casing having a laced region, and an outwardly extending lacing coupled to the laced region of the casing. (Pages 7 and 8, ¶¶ 0027 and 0029). The lacing has an exposed surface. (Page 9, ¶ 0032). At least a portion of the exposed surface of the lacing has a pebbled texture that is highly grippable when directly contacted by a user's hand. (Pages 10 and 11, ¶¶ 0037 and 0038). The football is configured for use in competitive play. (Pages 3 and 4, ¶ 0005, Page 8, ¶ 0029, Page 9, ¶ 0032, Pages 10 and 11, ¶¶ 0037 and 0038).

vi. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- a. Claims 1-3, 5, 7, 9, 10 and 51-64 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Horkan* (U.S. Patent No. 5,570,882) in view of *Martin* (U.S. Patent No. 5,570,882).

- b. Claims 4, 8, 11, 12 and 14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Horkan* in view of *Martin* and *Feeney* (U.S. Patent No. 6,283,881) because *Horkan* teaches away from a combination With *Martin* and/Or *Feeney*.
 - c. Claim 6 stands rejected under 35 U.S.C. 103(a) as being unpatentable over *Horkan* in view of *Martin* and *Finley* (U.S. Patent No. 4,991,842).
 - d. Claims 1-14 and 51-64 are provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 51 and 53-65 of copending Application No. 11/018,628.
- vii. **RESPONSE TO EXAMINER'S ANSWER – REJECTIONS UNDER 35 U.S.C. §103(a)**

In the Examiner's Answer, the Examiner reiterates: the rejections of claims 1-3, 5, 7, 9, 10 and 51-64 under 35 U.S.C. 103(a) as being unpatentable over *Horkan* (U.S. Patent No. 5,570,882) in view of *Martin* (U.S. Patent No. 5,570,882); the rejections of claims 4, 8, 11, 12 and 14 as being unpatentable over *Horkan* in view of *Martin* and *Feeney* (U.S. Patent No. 6,283,881); and the rejection of claim 6 under 35 U.S.C. 103(a) as being unpatentable over *Horkan* in view of *Martin* and *Finley* (U.S. Patent No. 4,991,842). The Examiner then presents a response to Appellants' arguments presented in the Appeal Brief.

Appellants fully maintain and support all of the positions stated in the Appeal Brief filed on December 17, 2007. Accordingly, Appellants will not reiterate its

statements from the Appeal Brief, but will respond to a few statements made in the Examiner's Answer.

Appellants respectfully submit that the statements in the Answer misapply or mischaracterize the direct and repeated teachings of *Horkan*. On page 3 and page 9 of the Examiner's Answer, the Examiner attempts to equate *Horkan's* "training aid" with lacing alone. The Examiner argues that the "appellant has taken a very narrow reading of the teachings of *Horkan*" Appellants respectfully disagree. Appellants simply follow the plain and ordinary meaning of the words and teaching of *Horkan*. *Horkan* could not be clearer in defining "training aid" as a modified football and glove combination which assists in teaching a player to correctly grasp and throw a football. Col. 1, lines 5-8. It is the combination of the hook and loop fastening material on the fingertips of the gloves of the user and the lacing of the football, respectively, that achieves *Horkan's* objective. *Horkan* is consistent and unwavering in his teaching as pointed out in pages 9 and 10 of the Appeal Brief.

Horkan wishes to train users, and in particular younger users, how to properly grasp a football in order to achieve "a proper throwing grip." Col. 1, lines 9-21. By replacing the lacing with loop fastening material (e.g. Velcro® loop fastening material) and requiring the user to wear gloves having the corresponding hook-type fastening material only at the fingertips, *Horkan* is able to facilitate and urge the proper grasping of a football by the gloved user. The loop-type fastening material (or hook-type fastening material) is necessarily less grippable to the other portions of the gloved

user's hand allowing the ball to easily move to the desired position where the hook-type fastening elements (or corresponding loop-type fastening elements) engage the corresponding loop-type fastening material of the lacing.

Horkan neither teaches nor desires to increase the grippability of the lacing in general to the user's hands. Rather, *Horkan* requires that the training aid provide an improved grasping of a football only by the gloved fingertips of the user. *Horkan* explains the undesirability of improving the grippability of the ball or lacing in general by distinguishing his invention from "known prior art devices" having Velcro® strips placed on the seams of a football for use by users with cotton gloves by stating that such devices do not enhance a proper throwing of the football. Col. 1, lines 23-31.

Horkan's consistent disclosure teaches away from a combination with *Martin* or any other construction that would increase the grippability of the lacing in general to the user's hands. *Horkan* desires improved gripping of the modified football only by the finger tips of the user, and to accomplish this, *Horkan* makes the lacing less grippable to other portions of the user's gloved hand so that improved gripping occurs only at the fingertips of the gloved user and not other locations such as the user's palms.

The Examiner's Answer misapplies this critical teaching of *Horkan* by proposing that the Velcro® material *Horkan* uses on his modified football can be replaced with the basketball cover material disclosed by *Martin*. A combination of this type is improper because it would defeat the objectives of *Horkan*. The user's

fingertips would not be more grippable than other portions of the user's hands and, as such, nothing would urge proper grasping of the football as required by *Horkan*.

Appellants provided the independent lab test results to further demonstrate *Horkan*'s teachings. *Horkan* does not teach improving the grippability of lacing to a user's hands as suggested in the Examiner's Answer. Rather, as demonstrated by the independent lab results, loop or hook fastening material (such as Velcro® type material) when used in isolation (apart from the corresponding hook or loop material) has a lower coefficient of friction than other conventional materials such as leather and synthetic leather. The increased frictional relationship occurs when the loop type material engages the hook type material and not when the materials are used in isolation. A user's ungloved hand would not include the corresponding hook type fastening material and as such the lacing having the loop fastening material as taught by *Horkan* would be less grippable to a user's hands than conventional football materials and not more grippable. It is only when the lacing of *Horkan* with the loop type (Velcro® type) fastening material engages the hook type fastening material (applied to the gloved fingertips of the user) that increased gripability occurs. Without the gloves with Velcro® hook fastening elements, the lacing of *Horkan* is less grippable to a user. Accordingly, replacing the loop type fastening material of *Horkan* with the basketball cover material of *Martin* would be completely contrary to the consistent and unwavering teachings of *Horkan*. Nothing would urge the user's hands into "a proper throwing grip" as required by *Horkan*. Rather, the grip from the proposed combination

would be the same for the palm of the user as the fingertips of the user, and nothing would direct, require or urge the user into a proper throwing grip. The Velcro fastening elements only at the fingertips of a glove is not commensurate with the teachings of *Martin* as proposed by the Examiner. One of ordinary skill in the art, upon reading *Horkan*, would not be motivated to combine its teachings with the disclosure of *Martin* or other forms of conventional pebbled basketballs because to do so would be directly contrary to the teachings of *Horkan*.

Further, *Martin* discloses a basketball having a pebbled surface, not unlike basketballs that have existed for decades. *Martin* does not mention a football, let alone laces of a football. Prior to the present Application (and its related Applications), no one has applied a pebbled, highly grippable material to the outer surface of football lacing. It is only through impermissible hindsight and a combination with *Horkan* (in a manner that is contrary to the teachings of *Horkan*) that one can arrive at the present rejection. Accordingly, Appellants respectfully submit that the present rejection should be reversed.


Further, Appellants respectfully submit that the results of the Re-Examination of U.S. Patent No. 6,964,625 are highly relevant to the present Appeal. As pointed out in the Appeal Brief, three Examiners agreed with Appellants that “*Horkan* specifically teaches away from improving the grip-ability of the lacing in general” and that *Horkan* taught away from a lacing having an exposed surface that is pebbled. Of course, the claims of the present Application are not identical to the claims of the ‘625 Patent. But

the present Application and the '625 Patent are from the same patent family and have many similarities. The *Martin* reference adds little to the analysis since it generally shows a form of a pebbled basketball not unlike basketballs that have existed for decades.

Horkan alone, or in combination with *Martin*, *Feeney* or *Finley*, does not teach, suggest or disclose the combination of elements of pending claims 1-12, 14 and 51-64, including, for example, "an outwardly extending lacing coupled to the laced region of the casing, the lacing having an exposed surface, at least a portion of the exposed surface of the lacing having a pebbled texture that is highly grippable when directly contacted by a user's hand...." Accordingly, Appellants respectfully submit that the final rejection of claims 1-12, 14 and 51-64 be reversed, and the claims allowed. Commissioner is also hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 501959.

Respectfully submitted,

Date 30 June 2009
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